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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WINTER, JOHN M

ART UNIT PAPER NUMBER

3621

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/770,353

Applicant(s)

KRISHNAN ET AL.

Examiner

John M. Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

STATUS

Claims 1-18 and 24-28 remain pending.

Claims 19-23 have been canceled.

Response to Arguments

The Applicant's arguments filed on April 1, 2005 have been fully considered.

The indicated allowability of claims 1-18 and 24-28 is withdrawn in view of the newly discovered reference to Coley et al. (US Patent 5,790,664) in view of Clark (US Patent 6,343,280). Rejections based on the newly cited reference follows. The Examiner apologized for the delay in the discovery of this new art.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention specifically the claimed feature of "a new encryption technique" imposes no limitation upon the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 18 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coley et al. (US Patent 5,790,664) in view of Clark (US Patent 6,343,280).

As per claim 1,

Coley et al ('664) discloses a computer network system for implementing digital commerce comprising:

a client portion comprising a plurality of components that are provided by a supplier server computer systems wherein the components are downloaded via the online purchasing code to a client computer system in response to the selection of electronic data to be licensed, the components including the selected electronic data with at least a portion of the data being

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encrypted; (Column 5, lines 9-22 [the software enabling message is the downloaded component] column 18, lines 48-65 in regards to encryption of data)

a licensing and purchasing server portion that provides an electronic licensing certificate in response to a request from a downloaded component to license the selected electronic data, wherein, when the selected electronic data is processed on the client computer system, it is decrypted only upon determination of existence of the electronic licensing certificate generated by the licensing and purchasing server. (Column 5, lines 9-31 column 18, lines 48-65 in regards to encryption of data)

Coley et al ('664) does not explicitly disclose comprising online purchasing code for selecting electronic data to be licensed and transmitted online. Clark ('280) discloses comprising online purchasing code for selecting electronic data to be licensed and transmitted online (Figure 3 [client purchases licenses]) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Coley et al.'s method with Clark's ('280)'s teaching in order to allow the consumer utilize authenticated copies of electronic media.

As per claim 2,

Coley et al ('664) discloses the system of claim 1

wherein the plurality of components includes encrypted digital content, a corresponding encrypted security information file that provides licensing and decryption data, and a licensing code module that requests licensing from the licensing and purchasing server portion when the encrypted digital content is processed (Column 7, lines 43-66, figure 1; column 18, lines 48-65 in regards to encryption of data).

As per claim 3,

Coley et al ('664) discloses the system of claim 1

wherein the electronic licensing certificate is encrypted by the licensing and purchasing server portion and decrypted when the downloaded selected electronic data is processed (Column 14, lines 45-67; column 18, lines 48-65 in regards to encryption of data).

As per claim 4,

Coley et al ('664) discloses the system of claim 1

4. The system of claim 3 wherein the licensing and purchasing server portion includes separate code modules for generating licenses and for receiving requests from the client portion, (Figure 2, elements 208 and 212; column 13, lines 56-62).

Coley discloses the claimed invention except for the license generating code module is replaced to incorporate a new licensing model. It would have been obvious to replace the code module in order to update the state of the software license.

As per claim 6,

Coley et al ('664) discloses the system of claim 1

wherein the licensing and purchasing server portion includes separate code modules for generating licenses and for payment processing, (Figure 2; column 8, lines 26-38).

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Coley discloses the claimed invention except for the payment processing module is replaced to incorporate a new licensing model. It would have been obvious to replace the payment processing module in order to update the state of the software.

As per claim 7

Coley et al ('664) discloses the system of claim 1

Official Notice is taken that " the online purchasing code allows selecting merchandise that is not to be transmitted online and wherein the licensing and purchasing server portion differentiates between selected electronic data to be downloaded and selected merchandise that is not to be transmitted online and transmits an order for physical shipment of selected merchandise that is not to be transmitted online" is common and well known in prior art in reference to electronic commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made to pay for an item electronically and receive a physical shipment in order to allow the user to seek a competitive price for the item.

As per claim 8,

Coley et al ('664) discloses the system of claim 1

wherein a plurality of electronic data selections can be licensed in response to a single licensing request sent to the licensing and purchasing server portion. (Column 12, lines 60-65)

As per claim 9,

Coley et al ('664) discloses the system of claim 1

wherein the components downloaded from the supplier server computer system are downloaded (Figure 1)

Coley discloses the claimed invention except for the usage of a background task. It would have been obvious to utilize background processing in order to optimize the performance of the clients computer system. The examiner notes that all modern computer systems are capable of performing background processes.

Claim 28 is in parallel with claim 9 and is rejected for at least the same reasons.

As per claim 10,

Coley et al. ('664) discloses a method in a computer system for facilitating digital commerce over a network, the method comprising:

receiving and storing a plurality of components that are associated with the selected item, the components including a content file that contains content for the selected item, the content file not able to be processed until the selected item is licensed in accordance with the purchasing option; and initiating processing of the content file, such that licensing code is executed before the content is processed, the licensing code causing the selected item to be licensed in accordance with the purchasing option so that the content file can be processed.

(Column 5, lines 9-31 [the server send a message to the client enabling usage upon validation of a license record])

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Coley et al ('664) does not explicitly disclose selecting an item of electronic data; indicating a purchasing option for the selected item. Clark ('280) discloses selecting an item of electronic data; indicating a purchasing option for the selected item (Figure 3 [client purchases licenses]) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Coley et al.'s method with Clark's ('280)'s teaching in order to allow the consumer utilize authenticated copies of electronic media.

As per claim 11,
Coley et al. ('664) discloses the method of claim 10,
wherein the selected item is licensed by a licensing and purchasing server. (Column 5, lines 9-31)

As per claim 12,
Coley et al. ('664) discloses the method of claim 10, further comprising:
receiving an electronic license certificate that indicates that the selected item is licensed; and
continuing processing of the content file. (Column 8, lines 1-14, figure 1)

As per claim 13,
Coley et al. ('664) discloses the method of claim 12
wherein a portion of the received content file is encrypted, and wherein the continuing
processing of the content file after receiving the electronic license certificate causes the
encrypted portion to be decrypted such that the content file can be processed. (Column 14, lines 45-67; column 18, lines 48-65 in regards to encryption of data).

As per claim 14,
Coley et al. ('664) discloses the method of claim 10
wherein a portion of the received content file is encrypted and further comprising:
determining that the selected item has been licensed in accordance with the purchasing option;
and decrypting the encrypted portion so that the content file can be processed.
(Column 14, lines 45-67; column 18, lines 48-65 in regards to encryption of data).

As per claim 15,
Coley et al. ('664) discloses the method of claim 10
wherein one of the received components is a user interface library that is used to indicate
the purchasing option for the selected item.(Figure 2, elements 208 and 212; column 13, lines 56-62).

As per claim 16,
Coley et al. ('664) discloses the method of claim 10
wherein the purchasing options include a trial use of the selected item. (Column 8, lines 49-53)

As per claim 17,
Coley et al. ('664) discloses the method of claim 10

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wherein the purchasing options include trial use, purchase, and rental of the selected item.
(Column 8 ,lines 49-52)

As per claim 18,

Coley et al. ('664) discloses the method of claim 10

Official Notice is taken that "the receiving and storing of the components is interrupted and further comprising resuming receiving and storing the components without again receiving any components already successfully received and stored" is common and well known in prior art in reference to network transmission of data. It would have been obvious to one having ordinary skill in the art at the time the invention was made to resume receiving data after an interruption in order to reduce network usage which causes network congestion.

As per claim 19,

Coley et al. ('664) discloses a method in a computer system for facilitating electronic commerce over a network, the method comprising:

generating an electronic license certificate in accordance with the purchasing option, the electronic license certificate indicating the parameters of the license;
and sending the generated electronic license certificate to the purchasing application.
(Column 5, lines 9-31 [the server send a message to the client enabling usage upon validation of a license record])

Coley et al ('664) does not explicitly disclose receiving a request from a purchasing application for a license for an indicated item, the request indicating a purchasing option. Clark ('280) discloses receiving a request from a purchasing application for a license for an indicated item, the request indicating a purchasing option (Figure 3 [client purchases licenses]) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Coley et al.'s method with Clark's ('280)'s teaching in order to allow the consumer utilize authenticated copies of electronic media.

As per claim 20,

Coley et al. ('664) discloses the method of claim 19

wherein the generated electronic license certificate is encrypted. (Column 18, lines 48-65)

As per claim 21,

Coley et al. ('664) discloses the method of claim 19

wherein the generating of the electronic license certificate is performed by a separate code module.(Figure 6, element 614)

As per claim 22,

Coley et al. ('664) discloses the method of claim 19

wherein the generating of the electronic license certificate is performed using a data repository having tables that define the license parameters to be used for the indicated item in accordance with the indicated purchasing option. (Figure 2)

As per claim 23,

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Coley et al. ('664) discloses the method of claim 19

Further comprising requesting authorization from a payment processing system when the indicated purchasing option is a purchase. (Column 8 ,lines 29-52)

As per claim 24,

Coley et al ('664) discloses a method in a networked computer system for performing digital commerce; the method comprising:

sending a request to download a plurality of components, at least a portion of the plurality of components being used to operate the selected item, the components including a content component and a licensing component; upon completion of downloading the plurality of components, invoking the downloaded licensing component to generate a license in accordance with the indicated purchasing option; and upon receiving a generated license, processing the content component so that the selected item is operable; under control of a supplier server system, receiving the request to download the plurality of components; sending the requested components to the virtual store; under control of the licensing component, sending a request to a licensing and purchasing server to generate the license; under control of the licensing and purchasing server, receiving the request to generate the license; generating the license in accordance with the indicated purchasing options; sending the generated license to the virtual store. (Column 5, lines 9-31 [the server send a message to the client enabling usage upon validation of a license record])

Coley et al ('664) does not explicitly disclose under control of a virtual store, selecting an item of electronic data to be licensed; indicating a purchasing option for the selected item. Clark ('280) discloses under control of a virtual store, selecting an item of electronic data to be licensed; indicating a purchasing option for the selected item. (Figure 3 [client purchases licenses]) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Coley et al.'s method with Clark's ('280)'s teaching in order to allow the consumer utilize authenticated copies of electronic media.

As per claim 25,

Coley et al ('664) discloses the method of claim 24

wherein communications with the licensing and purchasing server are implemented using a public key/private key cryptographic algorithm.(Column 18, lines 48-65)

As per claim 26,

Coley et al ('664) discloses the method of claim 24

wherein a portion of the downloaded content component is encrypted, and further comprising decrypting the encrypted portion only after receiving the generated license so that the selected item is not operable until the license has been generated in accordance with the indicated purchasing option.(Figure 2)

As per claim 27,

Coley et al ('664) discloses the method of claim 24

wherein the indicated purchasing option is chosen from at least the set of trial use and purchase. (Column 8, lines 26-38)

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Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to John Winter whose telephone number is (571) 272-6713. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to:

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Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]
(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the Knox Building, 50 Dulany St. Alexandria, VA.

JMW
June 11, 2005


SALVATORE CANGIALOSI
PRIMARY EXAMINER
ART UNIT 222